

Based on review of the claims, Applicants elect the claims of Group I, with traverse. Thus, claims 17-24 are selected explicitly for examination.

As an initial matter, Applicant traverses the restriction requirement on the grounds that the Office Action does not meet the burden for demonstrating that the allegedly independent or patentably distinct inventions I and II are unrelated. Quoting the standard set forth in the outstanding Office Action, it states that “inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP §802.01 and §806.06).” See Action p. 2, emphasis added. As illustrated in the standard set forth in the outstanding Office Action, for an invention to be unrelated, it must be shown that the alleged distinct inventions are 1. not disclosed as capable of use together AND 2. they have different designs, modes of operation, and effects. The outstanding Office Action utterly fails to demonstrate both requirements. Specifically, there is no discussion of how allegedly distinct inventions I and II are “not disclosed as capable of use together.” In fact, the content of claims 17-24 and 25-31 are taught and disclosed in Applicant’s Specification as specifically being capable of use together. Consequently, the present Restriction Requirement is improper and should be reconsidered and withdrawn.

Additionally, the present Restriction Requirement is improper since there is no “serious search and examination burden.” It is well known that the authority for the Director to require restriction appears in 35 USC 121, which authorizes the Director to impose a requirement for restriction whenever claimed inventions in one application are “independent and distinct.” See 35 USC 121. However, the MPEP contains an additional necessary condition that must be met by an Examiner before the examiner can impose a restriction requirement. This is, the requirement to show that there is a “serious burden” on the examiner to search and examine the allegedly independent or distinct claims. Specifically, the second paragraph of MPEP 803 states that: “[i]f the search and examination of ~~all~~ the claims in an application can be made without serious burden, the examiner must examine ~~them~~ on the merits, even though ~~they include~~ claims to independent or distinct inventions. MPEP 8th Edition, Rev. 5, 2006, *emphasis added*.

Timing is an important factor in determining whether a requirement for restriction is proper. Respecting timing for a restriction requirement, MPEP 811 cites to 37 CFR 1.142(a). Rule 1.142(a) states that:

§ 1.142 Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action. ... [Para (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997], *emphasis added*.

In discussing rule 1.142(a), MPEP 811 states that:

811 Time for Making Requirement [R-3]

37 CFR 1.142(a), second sentence, ***>indicates that a restriction requirement "will normally< be made before any action upon the merits; however, it may be made at any time before final action **."* This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. (*Emphasis added*).

The rule requirement that a restriction requirement will be made "as soon as the need for a proper requirement develops" indicates that a requirement for restriction after a first action should be made in response to a claim amendment resulting in claims that define "independent and distinct" inventions within the meaning of 35 USC 121. MPEP 811, first paragraph, does not expressly prohibit restriction after examination of otherwise restrictable claims. However, a "serious burden" in examination of claims already examined and the topic of at least two office actions simply cannot exist. (*See*, for example, decision on petition for application 09/478,351 dated 10/31/2008, signed by Group Director Coggins, for Technology Center 3600).

Specifically, in the present case, claims 17–31, which are presently before the Examiner, are all original claims, with the exception of claim 30 which was amended to correct a typo. That is, no amendment has been made to the independent claims. Consequently, any proper restriction requirement between claims 17-31 should have been made before any action on the merits. *See* 37 CFR 1.142(a). Since no substantive amendment has been made to any of claims 17-31, there has been and could not have been a

development of a “need for a proper requirement” necessitating a restriction requirement after the first action. *See* MPEP 811. Claims 17-31 have already been searched, without serious burden, and have been the topic of at least two office actions. In fact, claims 17-31 were indicated as allowed in paper number 20070723, dated 09/11/2007. To now require a Restriction of claims 17-31 would merely cause further unnecessary delay and expense to the Applicant and duplicative examination by the Patent Office.

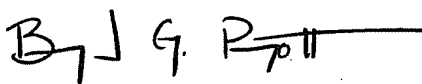
Again, Applicant respectfully submits that search and examination of groups I and II can be made without serious burden, as evidenced by the already nearly complete examination and indication of allowability of claims 17-31 present in the record. *See* MPEP §803, which states that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” (Emphasis added). This policy should apply in the present application to avoid any further unnecessary delay and expense to the Applicants and duplicative examination by the Patent Office.

Applicant believes no fee is due with this response. If any fee is due, please charge our Deposit Account No. 18-0013, under Order No. 40297-0001 from which the undersigned is authorized to draw.

Respectfully Submitted,

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